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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,597	09/19/2003	Tucker D. Maurer	1649-0008	6362

7590 12/29/2006  
Maginot, Moore & Beck LLP  
Chase Tower, Suite 3250  
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Indianapolis, IN 46204-5109

EXAMINER
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ZHENG, LOIS L

ART UNIT	PAPER NUMBER
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1742

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/665,597	<b>Applicant(s)</b> MAURER, TUCKER D.	
	<b>Examiner</b> Lois Zheng	<b>Art Unit</b> 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 20 and 43 are amended in view of the amendment filed 13 October 2006.

Therefore, claims 1-43 are currently under examination.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 19 and 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al. US 4,012,351(Hall) in view of Lum US 2,516,008(Lum), further in view of Brands et al. US 5,112,414(Brands), and further in view of Rodabaugh et al. US 5,702,534(Rodabaugh).

The teachings of Hall in view of Lum, Brands and Rodabaugh are discussed in paragraph 3 of the previous Non-Final Office Action mailed 13 July 2006. The rejection grounds for instant claims 1-8, 19 and 38-42 are maintained for the same reasons as stated in paragraph 3 of the previous Non-Final Office Action.

4. Claims 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall in view of Lum, Brands and Rodabaugh, and further in view of Rausch US 2,819,193 (Raush).

The teachings of Hall in view of Lum, Brands, Rodabaugh and Rausch are discussed in paragraph 4 of the previous Non-Final Office Action mailed 13 July 2006.

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The rejection grounds for instant claims 9-18 are maintained for the same reasons as stated in paragraph 4 of the previous Non-Final Office Action.

5. Claims 20-27, 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall in view of Lum, Brands and Rodabaugh, and further in view of Giordani et al. US 6,858,097 B2(Giordani).

The teachings of Hall in view of Lum, Brands and Rodabaugh are discussed in paragraph 3 of the previous Non-Final Office Action mailed 13 July 2006. However, Hall in view of Lum, Brands and Rodabaugh do not explicitly teach the claimed addition of soluble molybdenum in the passivation solution.

Giordani teaches a passivation solution used to treat stainless steel surfaces, wherein the passivation solution comprises phosphoric acid(col. 5 lines 14-15), free fluoride(col. 5 line 12), iron(col. 7 lines 48-58), and hydrogen peroxide(col. 5 line 59 – col. 6 line 15). Giordani further teaches the presence of dissolved molybdenum ions in the coating composition (col. 4 lines 17-19).

Regarding claims 20 and 43, it would have been obvious to one of ordinary skill in the art to have incorporated the dissolved molybdenum, as taught by Giordani into the passivating solution of Hall in view of Lum, Brands and Rodabaugh in order to improve the stability of hydrogen peroxide in the solution as taught by Giordani (col. 4 lines 9-19).

Regarding claims 21-27 and 37, the instant claims are rejected for the same reasons as stated in the rejections of instant claims 2-8 and 19 in paragraph 3 above.

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6. Claims 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall in view of Lum, Brands, Rodabaugh and Giordani and further in view of Rausch.

The teachings of Hall in view of Lum, Brands, Rodabaugh and Giordani are discussed in paragraph 3 above. However, Hall in view of Lum, Brands, Rodabaugh and Giordani do not explicitly teach the claimed inorganic activator as recited in claims 28-36.

The teachings of Raush are discussed in paragraph 4 above. Therefore, it would have been obvious to one of ordinary skill in the art to have incorporated the coating composition of Raush into activator of Hall in view of Lum, Brands, Rodabaugh and Giordani for the same reasons as stated in paragraph 4 above.

Regarding claims 28-36, the instant claims are rejected for the same reasons as stated in the rejections of instant claims 9 and 11-18 in paragraph 4 above.

### ***Response to Arguments***

7. Applicant's arguments filed 13 October 2006, have been fully considered but they are not persuasive.

Applicant argues that Hall's coating composition is not a passivation coating.

The examiner would like to thank applicant for detailed explanation of the difference between passivation layer, conversion coating and barrier coating. However, the examiner does not find applicant's argument convincing for three reasons. First, applicant's discussion of the definition of passivation is not sufficient without factual evidence data such as publications and prior art teachings. It is well settled that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*,

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346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case of obviousness."). Second, since the coating composition as taught by Hall contains the same components as the instantly claimed passivating composition. One of ordinary skill in the art would have found it obvious that the coating composition would have the same effect when applied to stainless steel. Therefore, the examiner maintains the position that the coating of metal surfaces as taught by Hall reads on the claimed passivation step. Third, the final result of the passivating step is the formation of an oxide layer. In contrary to applicant's position that the passivating is not coating, the examiner maintains that the oxide layer formed from passivation is a still a coating layer.

For the purpose of clarification, the examiner is interpreting the term "passivating" to mean forming a layer of corrosion resistant material through reaction of metal substrate surface with the coating composition. In addition, the passivating composition as claimed comprises phosphoric acid. Therefore, the examiner takes a position that the "passivating" composition as claimed encompasses any phosphoric acid containing coating composition including the phosphate coating solution.s

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LLZ

ROY KING  
SUPERVISORY PATENT EXAMINER  
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